

Application No.: 10/615,832
Art Unit: 2142

Response under 37 CFR §1.116
Attorney Docket No.: 030733

REMARKS

Claims 1-6 and 11-15 are pending in the application. Claims 11-14 have been cancelled. It is respectfully submitted that this Response is fully responsive to the Office Action dated August 29, 2008.

Claim Rejections - 35 USC § 112

Claims 1, 5, 11 and 15 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

Regarding claims 1, 5, and 15, the Examiner asserts that:

No support is provided in Applicant's specification for this negative limitation (that is, *not transmitting* the new mail notification...). The previously presented claim language as specified, "determines not to transmit **the electronic mail of** the new mail notification..." (emphasis added). However, Applicant has removed the "the electronic mail of" language, thus changing the scope of the claim language. The current claim language, noted above, is not supported by Applicant's disclosure (see page 5 of the Action).

That is, Examiner appears to allege that the original disclosure does not appear to include support for the claimed feature of "determines not to transmit the new mail notification by the push method protocol when the received electronic mail is a reception confirmation mail of electronic mail transmitted previously."

However, Applicant submits that page 13, line 28 through page 14, line 11 of the present specification calls for the following:

Application No.: 10/615,832
Art Unit: 2142

Response under 37 CFR §1.116
Attorney Docket No.: 030733

Then, the control unit 10 determines whether or not a new mail notification is required by the electronic mail address of the destination of the received electronic mail in accordance with the registered contents of the mailbox management table 160 (step S13). When the new mail notification is required (YES in step S13), the type of the received electronic mail is determined (step S14). Specifically, it is determined whether or not the received electronic mail is a reception confirmation mail for the electronic mail transmitted previously, and whether or not the received electronic mail is attached with an attached file.

Here, when the received electronic mail is a reception confirmation email, or when the received electronic mail is not attached with an attached file, the contents of the received electronic mail are generally only character codes. Thus, the amount of data generally does not become a problem

In view of the above, it is submitted that that the reception confirmation email is generally only made up of character codes which are small amounts of data. The system, therefore, is able to handle the small amount of data of the reception confirmation emails and does not have to send the reception confirmation emails via a push method protocol. Thus, the claimed subject matter in view of the original specification would be readily apparent to one of ordinary skill in the art.

Accordingly, withdrawal of this rejection is respectfully requested.

Application No.: 10/615,832
Art Unit: 2142

Response under 37 CFR §1.116
Attorney Docket No.: 030733

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 6 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang (US 6,292,825 B1) in view of Wakasugi (US 6,823,367 B1).

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang in view of Wakasugi as applied to claim 1 above, and further in view of Boyle (US 6,119,167).

Claims 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang in view of Eguchi (US Pub. 2002/0054363 A1) and further in view of O'Neal (US 6,711,154).

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang in view of Eguchi and O'Neal as applied to claim 11 above, and further in view of Wakasugi.

Each of these rejections are respectfully traversed.

Independent Claim 1:

With regard to Applicant's argument that the Examiner has failed to establish that a consumer in the Chang reference would designate a new mail notification of a reception confirmation mail of electronic mail transmitted previously as a low priority confirmation message, since the Examiner has failed to rely on any specific disclosure in the Chang

reference for supporting his position that receiving a new mail notification of a reception confirmation mail of electronic mail transmitted previously would be a low priority confirmation message chosen by the consumer, the Examiner takes the position that there are a finite number of options, specifically two options which are transmitting or not transmitting the reception confirmation email.

However, it is submitted that the references teach away from the option which appears in claim 1. The Chang and Wakasugi references disclose the user selecting which messages/notifications to receive, unlike claim 1, "wherein the means for transmitting determines not to transmit the new mail notification by the push method protocol when the received electronic mail is a reception confirmation mail of electronic mail transmitted previously." More specifically, the Wakasugi reference explicitly teaches away from the Examiner's position, since Wakasugi clearly discloses in step S402 in the flowchart of Fig. 10 that mail notification of the reception of delivery confirmation mail or notification mail is sent to a notification address. That is, it is respectfully submitted that Wakasugi clearly discloses that the reception of delivery confirmation E-mail is a high priority since a mail notification regarding reception of delivery confirmation E-mail is sent to a notification address.

Therefore, it is submitted that the features of claim 1 are not disclosed or fairly suggested by Chang and Wakasugi.

Independent Claim 5:

The Examiner admits that Chang in view of Wakasugi does not teach the “means for registering whether or not to carry out the new mail notifications to each of a plurality of electronic mail addresses” and “wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering.” However, the Examiner argues that Boyle shows these features and that it would have been obvious to one of ordinary skill in the art to modify the disclosure of Chang in view of Wakasugi with that of Boyle.

The portion of the Boyle reference cited by the Examiner discloses the user’s ability to request mail service not to push any data, to push only certain types of notifications, or to push new mail notifications only when a minimum of predetermined number of messages has been received (see col. 11, line 59-col. 12, line 10 of Boyle).

Applicant does not agree with the Examiner’s arguments against claim 5. Boyle fails to disclose or fairly suggest a “means for registering whether or not to carry out the new mail notification to *each* of a plurality of electronic mail addresses.” There is no suggestion in Boyle for the mail service request to be applied to “*each* of a plurality of electronic mail addresses.” The Boyle reference speaks in terms of a single user account and is silent as to possible applications to a plurality of electronic mail addresses. Therefore, all of the features of claim 5 are not taught or fairly suggested by the references.

Application No.: 10/615,832
Art Unit: 2142

Response under 37 CFR §1.116
Attorney Docket No.: 030733

Accordingly, even if, assuming *arguendo*, that the Chang, Wakasugi and Boyle references can be combined in the manner suggested by the Examiner such combination would still fail to teach or fairly suggest the features of claim 5 regarding “means for registering whether or not to carry out the new mail notifications to each of a plurality of electronic mail addresses” and “wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering.”

In view of the aforementioned amendments and accompanying remarks, Applicant submits that the claims, as herein amended, are in condition for allowance. Applicant requests such action at an early date.


If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

Application No.: 10/615,832
Art Unit: 2142

Response under 37 CFR §1.116
Attorney Docket No.: 030733

If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read 'TEB', with a long horizontal flourish extending to the right.

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